



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/045,632

10/26/2001

Susan M. Milberger

020375-000230US

9798

20350 7590 10/14/2008
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

CHANDLER, SARA M

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|--------------------------------------|---|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/045,632 | Applicant(s) MILBERGER ET AL. | |
| | Examiner SARA CHANDLER | Art Unit 3693 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2-8, 11, 12, 14-19, 22 and 24-30.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/JAGDISH N PATEL/
 Primary Examiner, Art Unit 3693

Continuation of 11. does NOT place the application in condition for allowance because:

1. Double Patenting - Withdrawn in light of terminal disclaimer.
2. Claim objections/ 112 rejections - Withdrawn in light of applicant's amendments.
3. Priority/102- Maintained.

Contrary to applicant's assertion, support for all claim elements must be found in the prior application in order for the claim to receive the benefit date of the prior application.

The present application 10/045,632 was filed October 26, 2001. The application is a CIP of each of (a) 09/613,615 filed July 11, 2000; (b) 09/476,384 filed December 30, 1999; and (c) PCT/US01/22,179 filed July 11, 2001. Although the application claims the benefit of these earlier filed applications, the claimed invention is not entitled to the earlier benefit dates because support cannot be found for the claimed invention in the earlier filed applications. Thus, the present application is entitled to its actual filing date of October 26, 2001.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). See also MPEP 201.11.

Farris, US Pub. 2002/0082962 is a publication dated June 27, 2002 of application 09/917,439 filed July 27, 2001 and claims the benefit of provisional application 60/221,042 which was filed July 27, 2000. Provisional application 60/221,042 provides support (e.g., See 60/221,042, Figs. 1,3 and pgs. 1-5, 7-11, 13-15, 22-29, 40-43) for the subject matter disclosed in US Pub. 2002/0082962.

For example see the following excerpt from pgs. 23,24 of 60/221,042:

The present invention 1 has developed technology, apparatus, methods, integrated systems, and business methods for providing a system of accepting any form of payment, not limited to cash, coins, bank draft, credit card, debit card, stored value card (smart card or prepaid magnetic cards), electronic or any other form of cash value from one (the "Local Device") unattended Electronic Data Capture device (the ~System") and thereafter transferring, converting or exchanging the input value received at the local device to an unlimited number of products and services that may be dispensed, printed or transferred to any form of acceptance at the local device (device of value input), to a second device located within the domestic United States or to a foreign device located within another country.

The concept comprises of a number of components, proprietary software and other elements to accomplish capturing the cash or stored value from an unlimited number of resources including and not limited to other forms of payment that would ultimately be converted or transferred to a other instruments of monetary value (representing currency or a governmental obligation), product or service and be credited to another form of acceptance and printed on one or various forms or any form of media, either in whole or in part.